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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Menard, Inc.

Serial No. 75558087

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103 (Michael Hamilton, Managing Attorney).

Before Hairston, Walters, and Drost, Administrative
Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

On September 24, 1998, Menard, Inc. (applicant),
applied to register the mark COMMANDER (typed) on the
Principal Register for goods ultimately identified as
"doors, door panels, door frames, door casings and door
units of metal sold exclusively through MENARDS® home
improvement retail stores" in Class 6.¹ The examining
attorney has refused to register applicant's mark under

¹ Serial No. 75558087. The application contains an allegation of
a date of first use of February 1998 and in commerce of September
1998.

Section 2(d) of the Trademark Act (15 U.S.C. § 1052(d)) because of a prior registration for the mark WEATHER COMMANDER (typed) for "building materials, namely, non-metal doors" in Class 19.² When the examining attorney maintained the refusal, this appeal followed.

Our principal reviewing court has set out thirteen factors that are appropriate to consider in likelihood of confusion cases. In re Majestic Distilling Co., 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). See also In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); and Recot, Inc. v. Becton, 214 F.3d 1322, 54 USPQ2d 1894, 1896 (Fed. Cir. 2000). More specifically, the Court's predecessor explained that "[t]he fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

The first factor we will consider is the similarities and dissimilarities of the marks. In this case, applicant seeks registration for a mark comprising the single typed

² Registration No. 2,646,047, issued November 5, 2002. The underlying application was filed on June 4, 1998, and it was amended to assert a date of first use of July 12, 2000.

word COMMANDER. The cited registration is also for a typed mark but it is for the words WEATHER COMMANDER. Obviously, there is one similarity, i.e., both marks contain the same word COMMANDER, and one difference, i.e., registrant's mark adds the word WEATHER. Regarding the common word COMMANDER, it appears to be arbitrary or suggestive when used with doors. There is no evidence that the term is weak or commonly used in the trade.

Furthermore, the examining attorney has included evidence in the form of copies of trademark registrations that supports his conclusion that the term WEATHER has at least a highly suggestive connotation when used with the goods. See, e.g., Registration No. 2,128,467 (WEATHER KING for metal doors and windows); No. 1,344,433 (WEATHERBLOC and design for insulated doors); No. 2,173,380 (WEATHERSAFE for non-metallic doors); No. 2,126,602 (WEATHER BREAK for thermal-barrier type sliding glass doors); No. 2,085,821 (WEATHER SHIELD for metal windows and doors); No. 2,368,864 (WEATHER STOPPER for vinyl windows and doors); and No. 808,327 (WEATHERBAR for steel and aluminum rolling doors).

In analyzing whether marks are similar, "there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of the mark, provided [that] the ultimate conclusion rests

on consideration of the marks in their entirety." In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). In this case, we have considered the marks in their entirety without disregarding the term "Weather," however, we find that both marks are dominated by the identical, common term "Commander." Registrant's additional term "Weather" will likely be viewed as simply a modifier of the term "Commander," e.g., a door that is better suited to handle extremes in weather. Therefore, the marks are similar in sound, appearance, meaning and commercial impression. Wella Corp. v. California Concept Corp., 558 F.2d 1019, 194 USPQ 419, 422 (CCPA 1977) (CALIFORNIA CONCEPT and surfer design likely to be confused with CONCEPT for hair care products). See also In re Dixie Restaurants, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997) (Federal Circuit held that, despite the addition of the words "The" and "Cafe" and a diamond-shaped design to registrant's DELTA mark, there was a likelihood of confusion).

We have also considered the case of In re Swenson Spreader Co., 222 USPQ 647 (TTAB 1984). In that case, the board found that the mark FIELD COMMANDER for fertilizer spreading machines for farm use was not confusingly similar to the mark TURF COMMANDER for tractors and gang lawn

mowers therefor for industrial use only. The board found that "[a]side from the military connotation which one might ascribe to FIELD COMMANDER, the words 'FIELD' and 'TURF' in both marks have only vaguely similar meanings and have obvious differences in appearance and pronunciation." 222 USPQ at 648.³ As discussed above, the differences between COMMANDER and WEATHER COMMANDER are much less significant and overall the commercial impressions of these marks would be similar.

We next address the similarities and dissimilarities in applicant's and registrant's goods. "Applicant concedes that Applicant and Registrant's goods are similar" (Reply Br. at 6), but disputes the examining attorney's contention that they are identical. Applicant's goods are "doors, door panels, door frames, door casings and door units of metal sold exclusively through MENARDS® home improvement retail stores," while registrant's goods are "building materials, namely, non-metal doors." Certainly, both identifications of goods include doors in general although it is clear that the doors would be made of different materials (metal v. non-metal). Setting aside for the moment the limitation of where applicant's goods are sold, applicant's and registrant's goods are identical doors with

³ The board also found that the goods "differ sufficiently." Id.

the difference being applicant's doors are metal while registrant's goods are non-metal.

The examining attorney has included several registrations that suggest that metal and non-metal doors have been registered by the same entity under a common mark. See, e.g., Registration No. 2,454,518 (metal doors and door frames and non-metal doors and door frames); No. 2,176,615 (residential metal doors and residential non-metal doors); No. 2,656,163 (metal windows and doors and non-metal windows and doors); and No. 2,678,839 (Non-metal doors and metal doors). These registrations are at least some evidence that metal and non-metal doors would be sold by the same entity under a common mark. See In re Mucky Duck Mustard Co., 6 USPQ2d 1467, 1470 n.6 (TTAB 1988) (Although third-party registrations "are not evidence that the marks shown therein are in use on a commercial scale or that the public is familiar with them, [they] may have some probative value to the extent that they may serve to suggest that such goods or services are the type which may emanate from a single source"). See also In re Albert Trostel & Sons Co., 29 USPQ2d 1783, 1786 (TTAB 1993).

In addition, we note that applicant itself sells non-metal and metal exterior doors and advertises them on the same page of its circular. See Advertising circular, p. 15

("COMMANDER™ 32" or 36" Traditional Pre-Hung Exterior Insulated Steel Doors" and "Storm & Screen Doors - 32" or 36" White Self-Storing Traditional - Tough textured vinyl over a durable wood core").

The record convinces us that non-metal and metal doors would be sufficiently related such that, if similar marks were used on these goods, there would be a likelihood of confusion. However, in this case applicant has amended its identification of goods to limit its doors and door-related products to those that are sold exclusively through MENARDS® home improvement retail stores. We must consider the goods as they are identified in the application and the cited registration. Paula Payne Products v. Johnson Publishing Co., 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) ("Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods"). However, even considered with this limitation, the goods of applicant and registrant are related.

We begin by noting that whether goods are related is not a simple matter of showing that the goods will not appear in the same store. Indeed, the fact that goods are sold in the same stores does not establish that there is a likelihood of confusion. See Federated Foods, 192 USPQ at

29 ("A wide variety of products, not only from different manufacturers within an industry but also from diverse industries, have been brought together in the modern supermarket for the convenience of the customer. The mere existence of such an environment should not foreclose further inquiry into the likelihood of confusion arising from the use of similar marks on any goods so displayed." Board's finding of likelihood of confusion affirmed as to some goods, reversed as to other) (emphasis in original).⁴

Second, "it has often been said that goods or services need not be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is enough that goods or services are related in some manner or that circumstances surrounding their marketing are such that they would be likely to be seen by the same persons under circumstances which could give rise, because of the marks used thereon, to a mistaken belief that they originate from or are in some way associated with the same producer or that there is an association between the

⁴ Applicant also refers to In re Shoe Works Inc., 6 USPQ2d 1890 (TTAB 1988) and argues that the channels of trade limitation established that there was no likelihood of confusion. However, in that case, there were numerous other factors, not the least of which was applicant's submission of a detailed consent agreement as well differences in the goods (shoes v. shorts and pants), that resulted in the board's conclusion that there was no likelihood of confusion.

producers of each parties' goods or services." In re Melville Corp., 18 USPQ2d 1386, 1388 (TTAB 1991). See also In re Martin's Famous Pastry Shoppe, Inc., 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); In re International Telephone & Telegraph Corp., 197 USPQ 910 (TTAB 1978).

In this case, even with the limitation of applicant's goods, the goods of applicant and registrant are likely to be encountered by the same purchasers. Purchasers may be interested in more than one type of door and purchasers would shop in more than one store for doors. Furthermore, a purchaser considering a replacement for a door would likely consider the advantages of both metal and non-metal doors. Purchasers who are comparison shopping for doors could easily encounter registrant's WEATHER COMMANDER non-metal door in one store and then see applicant's COMMANDER metal door in applicant's store. Consumers shopping in this manner would likely believe that there was some association or relationship between the source of COMMANDER doors and WEATHER COMMANDER doors.⁵ Therefore, we conclude

⁵ In addition, nothing in registrant's identification of goods prevents registrant's goods from being sold in applicant's stores. Of course, applicant may voluntarily refuse to carry registrant's doors, but there is nothing in the identification of goods that would require this. We do not read limitations into the identification of goods or services. Squirtco v. Tomy Corp., 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir. 1983)

that applicant's metal doors sold exclusively in its stores and registrant's non-metal doors are related.

Finally, applicant argues that "Applicant and Registrant's marks have coexisted in the marketplace for several years and there have been no instances of actual confusion." Particularly, in an ex parte case, the absence of actual confusion is hardly unusual and seldom is a significant factor in finding that there is no likelihood of confusion. Majestic Distilling, 65 USPQ2d at 1205 ("The lack of evidence of actual confusion carries little weight"). Applicant cites the case of In re General Motors Corp., 23 USPQ2d 1465 (TTAB 1992) as support for its position that the lack of actual confusion should be significant in this case. However, the differences between General Motors and applicant's case are striking. General Motors submitted evidence of nearly thirty years of simultaneous existence without confusion of the GRAND PRIX marks, the fame of its mark, and the sale of more than 2,600,000 vehicles. In applicant's case, registrant's date of first use is listed as July 12, 2000, so there is a much shorter period of potential overlap. In addition, the evidence of use and lack of actual confusion is certainly much weaker than in the General Motors case. Thus, there is no basis to deviate from the normal rule that the lack

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of actual confusion does not provide much support for the argument that there is no likelihood of confusion.

Decision: The examining attorney's refusal to register applicant's mark on the ground that it is likely to cause confusion with the cited registered mark used in connection with the identified goods under Section 2(d) of the Trademark Act is affirmed.